

**REMARKS**

This is in response to the Office Action mailed on February 12, 2004, in which all pending claims 1, 2 and 12-21 were rejected. Specifically, claims 1, 2 and 12-21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hilding (USP 3,937,491) or Holt (USP 5,405,168).

Hilding '491 discloses a note pad having a cardboard base (12) and a resilient deformable material (16) such as sponge rubber or styrofoam on the bottom to increase the coefficient of friction on the bottom of the pad. The pad also includes a pad support member (18) and other spaced supports (20) formed of a slippery material having a low coefficient of friction, so that the note pad can be easily slid across a work surface when pressure (such as by writing) is not applied, and so that the note pad has high friction when pressure is applied. Figure 4 illustrates the situation when pressure is applied to the note pad, bringing the resilient deformable material (16) into contact with the supporting desk surface.

Independent claim 1, as amended, recites a note pad having a base sheet with a bottom face bearing an exposed skid-resistant layer that defines a uniform bottom surface of the note pad and has a thickness of less than 100  $\mu\text{m}$ . The material of the skid-resistant layer exhibits a static coefficient of friction of more than 1, so that the note pad does resist lateral sliding across a surface. By contrast, Hilding '491 employs a skid-resistant layer (resilient deformable material 16) that is thicker than 100  $\mu\text{m}$ , since its skid resistant properties are due to its deformation under pressure. This is discussed in the instant application at page 11, line 23 - page 12, line 4. In addition, the resilient deformable layer (16) of Hilding does not define a uniform bottom surface of the note pad, as supports (18) project beyond the surface of the resilient deformable layer (16). Thus, at least two elements recited in amended independent claim 1 are not disclosed by the Hilding '491 patent.

The Examiner has contended that it would have been obvious to modify Hilding to provide a thickness of less than 100 microns "based on optimization through routine experimentation." However, as was discussed in the instant application at page 11, line 23 - page 12, line 4, materials such as the resilient deformable layer (16) of Hilding achieve their skid resistance as a bulk property, meaning that a certain thickness is required in order to retain the

deformability of the material that provide skid resistance. As a result, these types of materials could not be made as thin as 100 microns while providing effective skid resistance. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. M.P.E.P. 2143.01. If a proposed modification would render a prior art invention unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. M.P.E.P. 2143.01, citing In re Gordon, 221 U.S.P.Q. 1125 (Fed. Cir. 1984). Here, modifying the size of Hilding's resilient deformable layer (16) to be less than 100 microns would cause that layer to lose its skid resistance properties, rendering the Hilding note pad unsatisfactory for its intended purpose of providing a skid resistant note pad. As such, this modification is not permissible as there is no teaching or suggestion to make it. The rejection of claim 1 under 35 U.S.C. § 103 over Hilding should accordingly be withdrawn.

In addition, even if Hilding were modified as suggested by the Examiner, the resulting modified note pad would still not have a skid-resistant bottom surface that defines a uniform bottom surface of the note pad. Hilding's supports (18) project beyond the surface of the resilient deformable layer (16), regardless of the thickness of the resilient deformable layer (16). In order to reject a claim under 35 U.S.C. § 103 as being obvious, all of the claim limitations must be taught or suggested by the prior art. See M.P.E.P. 2143.03, citing In re Royka, 180 U.S.P.Q. 580 (C.C.P.A. 1964). In this case, even when the prior art is modified (which is not believed to be proper, as discussed above), the modified prior art does not teach or suggest a skid-resistant layer that defines a uniform bottom surface of the note pad, as recited by amended claim 1. The rejection of claim 1 under 35 U.S.C. § 103 over Hilding should therefore be withdrawn for this reason as well.

Holt '168 discloses a combination computer mouse pad and note pad for providing a work surface on which notes can be written and a computer mouse can be operated. The paper of the note pad is textured so that consistent contact with the computer mouse is maintained. The pad also includes a base (30) formed of a stiff material such as hard chip board, which "provides friction

between a support surface and the base 30 such that the combination pad 10 stays in place while being used."

Independent claim 1, as amended, recites a note pad having a base sheet with a bottom face bearing an exposed skid-resistant layer that defines a uniform bottom surface of the note pad and has a thickness of less than 100  $\mu\text{m}$ . The material of the skid-resistant layer exhibits a static coefficient of friction of more than 1, so that the note pad resists lateral sliding across a surface.

The Examiner contended that while Holt '168 does not teach that the friction layer has a thickness of less than 100 microns or that the layer exhibits a static coefficient of friction more than 1, it would have been obvious to modify Holt by providing the claimed thickness and friction coefficient based on optimization through routine experimentation. The Applicant disagrees with this contention for a number of reasons. First, it is not possible to make a layer of a wood or similar material such as chip board as thin as 100  $\mu\text{m}$ . This modification of Holt is neither taught or suggested, nor is it physically possible. Second, a material such as hard chip board does not provide a static coefficient of friction of more than 1, nor does Holt teach or suggest that it does. Thus, at least two elements of claim 1 cannot be achieved by optimization of the teachings of Holt '168, but would instead require a complete redesign of the base material used. Without the existence of the instant application, one skilled in the art would not have any motivation to perform this redesign of the base material of Holt, as the only suggestion for such a modification is the hindsight afforded by the instant application. Accordingly, the rejection of independent claim 1, under 35 U.S.C. § 103 over Holt should be withdrawn.

Claims 2 and 12-19 depend from amended independent claim 1, and are allowable therewith. In addition, it is respectfully submitted that the combinations of features recited in claims 2 and 12-21 are patentable on their own merits, although this does not need to be specifically addressed herein since any claim depending from a patentable independent claim is also patentable. See M.P.E.P. 2143.03, citing In re Fine, 5 U.S.P.Q.2d (BNA) 1596 (Fed. Cir. 1988). For example, none of the prior art references of record disclose, teach or suggest the various properties and

compositions of the skid-resistant material recited in the dependent claims. The rejections of claims 2 and 12-19 should accordingly be withdrawn.

Claims 20 and 21 are drawn to a method of preparing a note pad according to claim 1. Because the note pad of claim 1 is not disclosed, taught or suggested by the prior art references of record (for the reasons discussed above), the method of preparing the note pad of claim 1 is also not disclosed, taught or suggested by the prior art references of record. Accordingly, the rejections of claims 20 and 21 under 35 U.S.C. § 103 should be withdrawn.

Claim 16 has been amended to correct a typographical error.


#### CONCLUSION

In view of the foregoing, all pending claims 1, 2 and 12-21 are in condition for allowance. A Notice to that effect is respectfully requested.

Respectfully submitted,

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